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FISH & RICHARDSON P.C.
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER
HAMILTON, LALITA M

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte RICHARD DOUGLAS ALLAN and
BERNARD JOSEPH CAMPBELL

———

Appeal 2009-001167
Application 09/696,099
Technology Center 3600

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Decided: April 23, 2010

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Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
ANTON W. FETTING, *Administrative Patent Judges.*

LORIN, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE[1]

The Appellants have filed a Request for Rehearing, under 37 C.F.R.
§ 41.52, of the Decision by the Board (1) to clarify the claims whose
rejection are affirmed and reversed and (2) for reconsideration of the
decision to enter a new ground of rejection of claims 22-24 under 35 U.S.C.
§ 112, second paragraph.

DECISION

(1) The Appellants are correct. The first sentence in the "Decision"
section on page 14 of the Decision should read, "The decision of the
Examiner to reject claims 1-6 and 14-21 is affirmed and to reject claims 7-
13 and 22-25 is reversed." This would be consistent with statements made
in the Analysis and the Conclusion of Law sections of the Decision. The
Request for Rehearing is granted to the extent that the Decision is so
modified.

(2) We will not grant the Request for Rehearing for reconsideration of
the decision to enter a new ground of rejection of claims 22-24 under 35
U.S.C. § 112, second paragraph.

In the Decision (pp. 13-14), we stated the following:

> Claim 22 recites a means-plus-function limitation. Claim 22
> recites "at least one transaction unit including means for performing
> value transactions under the control of the processor executing code
> uploaded from the transaction unit." A means-plus-function

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[1] Our decision will make reference to the Appellants' Request for Rehearing
("Request," filed Jan. 14, 2010) and the Board of Patent Appeals and
Interferences' Decision ("Decision," mailed Nov. 20, 2009), and the
Appellants' Specification ("Spec.," filed Oct. 25, 2000).

> limitation is construed to cover the corresponding structure, materials, or acts described in the written description of the Specification and equivalents thereof. However, the Specification does not describe structure corresponding to this limitation.
>
> We note that the Appellants, in the Appeal Brief, cite to page 6, lines 18-20 and page 11, lines 11-14 of the Specification as support for this limitation. From those passages, we find that the claimed transaction unit corresponds to transaction units 4, 6, 8, and 10 in the Specification and that the claimed code executed by the processor and uploaded from the transaction unit are modules 30, 32, and 34 in the Specification. However, we do not find the corresponding structure for the claimed *means for performing value transactions*, which is part of the transaction unit in these passages or the remainder of the Specification. Therefore, we cannot construe the limitation and the claims are indefinite.

Emphasis original.

The Appellants dispute the Board's finding that the Specification fails to disclose structure corresponding to the function recited in the claim 22 means-plus-function clause, *i.e.*, "at least one transaction unit including means for performing value transactions under the control of the processor executing code uploaded from the transaction unit." Request 2. The Appellants make a number of arguments in an attempt to show that the Specification discloses sufficient structure corresponding to the recited function.

The first argument is:

> [T]he Specification discloses several examples of transaction units, including a coin validator 4, a banknote validator 6, a card reader 8 and a vending machine controller 10 (page 4, line 12 - page 5, line 14). There are well-known types of transaction units whose general structure for performing value transactions is (and would have been at the time the application was filed) well known to a person of ordinary skill in the art.

Request 3. The difficulty with this argument is that we cannot find any mention of the transaction units performing "value transactions."

As we stated in the Decision (*see supra*), claim 22 recites "at least one transaction unit including means for performing value transactions under the control of the processor executing code uploaded from the transaction unit." We therefore have looked to the Specification for structure corresponding to the function "performing <u>value transactions</u> under the control of the processor executing code uploaded from the transaction unit." We could not find any such structure. The Appellants argue that transaction units, including a coin validator 4, a banknote validator 6, a card reader 8 and a vending machine controller 10, are well known to perform "value transactions." But we find no evidence supporting the Appellants' contentions elsewhere in the record. *See generally, In re Glass*, 474 F.2d 1015, 1019 (CCPA 1973). We have read the Specification in its entirety and it appears that the phrase "value transaction" is disclosed only at line 3 of page 1 and in the claims, and in those disclosures the phrase is used only when referring to the system as a whole and not to the transaction units, including a coin validator 4, a banknote validator 6, a card reader 8 and a vending machine controller 10, which comprise the system. Claim 22 requires "at least <u>one transaction unit including means for performing value transactions</u> under the control of the processor executing code uploaded from the transaction unit." But based on our reading of the Specification, the means for performing value transactions is not included in any transaction unit but is a function of the system as a whole.

The second argument is:

> [T]he Specification expressly discloses further structural details of the transaction units for performing value transactions. For example, the Specification (at page 8, line 1-13) discloses that each transaction units 4, 6, 8, 10 includes a respective controller.

Request 3. We have the same difficulty with this argument as we have with the first argument. We cannot find any mention of the transaction units performing "value transactions." Page 8, lines 1-13, describes at best the individual "functions performed by the software modules" (Spec., p. 8, l. 7). But there is no mention of the transaction units including means for performing "value transactions."

The third argument is:

> The Specification (*e.g.*, at page 4, lines 13-15; page 5, lines 3-5,6 and 11-12) further discloses that each of the transaction units includes a respective interface 14 for sending and receiving signals along a bus (*e.g.*, USB 12). Such signals can include credit signals from the coin changer, banknote validator and card reader, and product selection information from the vending machine controller (page 8, lines 10-13). Likewise, the Specification discloses (at page 5, lines 11 - 13; page 11, lines 4-7) discloses that the vending machine controller 10 enables the vending of products in response to signals received along bus 12. The specification (at page 3, lines 13-22) also identifies an example protocol used to facilitate the various functions carried out by the individual transaction units.

Request 3. We have the same difficulty with this argument as we have with the first argument. We cannot find any mention of the transaction units performing "value transactions" in the disclosures cited by the Appellants. To the extent the Appellants are urging that the disclosed transaction units necessarily perform a "value transaction" as that term is used in the claims (notwithstanding that phrase "value transaction" is used in the claims only in

the context of the system as a whole and not as part of an individual transaction unit), the record at present does not support it. The Appellants draw our attention, for example, to page 11, ll. 4-7 where the vending machine controller is discussed. There it is stated that "product price values" are sent to the transaction controller module 35 which then sends a product dispense signal to the controller 10 (*i.e.*, transaction unit). But we do not see there sufficient description of the transaction unit performing a "value transaction", let alone sufficient description of a *structure* of a means *included* in the transaction unit for performing a value transaction under the control of the processor executing code uploaded from the transaction unit.

> The last argument is:

> The Specification discloses further details regarding the coin and banknote validators. For example, the Specification (at page 2, lines 8- 10) discloses that the coin and banknote validators include sensors, whose signals are used to determine the coin or banknote validity. Additionally, the Specification (at page 4, lines 15-16) discloses that the coin changer includes coin stores for change payout purposes.

We have the same difficulty with this argument as we have with the first argument. We cannot find any mention of the coin and banknote validators' transaction units performing "value transactions." The disclosures at page 2, lines 8-10 and page 4, lines 15-16 do not say otherwise. The former mentions coin or banknote validity and the latter mentions a coin changer "for change payout purposes." In neither of these disclosures do we see sufficient description of the transaction unit performing a "value transaction", let alone sufficient description of a *structure* of a means *included* in the transaction unit for performing a value transaction under the control of the processor executing code uploaded from the transaction unit.

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CONCLUSION

We have carefully considered the arguments that the Appellants have set forth in the Request but, for the foregoing reasons, we do not find them persuasive as to error in the decision to enter a new ground of rejection of claims 22-24 under 35 U.S.C. § 112, second paragraph.

<u>GRANTED-IN-PART</u>

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FISH & RICHARDSON P.C.
P.O. BOX 1022
MINNEAPOLIS MN 55440-1022